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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/607,888	06/27/2003	Kate O'Hara	100041-41191	7243
27805	7590	10/04/2004	EXAMINER	
THOMPSON HINE L.L.P. 2000 COURTHOUSE PLAZA, N.E. 10 WEST SECOND STREET DAYTON, OH 45402			CARTER, MONICA SMITH	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,888

Applicant(s)

O'HARA, KATE

Examiner

Monica S. Carter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8 and 10-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 10-41, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3, 5-8, 10-12, 43 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 12-13, it is not clear what is meant by the recitation "a having size and shape".

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13-17, 19-32 and 34-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman ('841).

Friedman discloses a notebook comprising a stack of papers (38); and a pouch (10) having generally the same size and shape in top view as the stack of papers (as seen in figure 2), the pouch including an inner cavity (as seen in figure 1); the pouch being generally rectangular in top view (as seen in figure 2) and including a pair of lateral edges and a pair of longitudinal edges; wherein the pouch is bound to the stack of papers along one of the lateral edges (see figure 2).

Friedman discloses the claimed invention except for the claimed dimensions of the pouch. It would have been an obvious matter of design choice to provide any desired dimensions for the pouch, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 14, see the above rejections to claim 13.

Regarding claim 15, the notebook includes a binding mechanism (36) binding together the stack of papers and the pouch.

Regarding claim 16, Friedman discloses the binding mechanism being a spiral binding mechanism (as seen in figure 2).

Regarding claim 17, at least part of the binding mechanism extends through the stack of papers and the pouch to bind the stack of papers and the pouch (as seen in figure 2).

Regarding claim 19, the notebook includes a rear cover (45) bound to the stack of papers and the pouch by the binding mechanism (as seen in figure 2), the rear cover having a greater stiffness than a paper of the stack of papers (see col. 3, lines 26-28).

Regarding claim 20, the rear cover is bound to the stack of papers and the pouch such that the stack of papers can be located between the pouch and the rear cover (as seen in figure 2 – the stack of papers 38 are between the rear cover 45 and the pouch 10).

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Regarding claims 21 and 23, Friedman discloses the pouch being "made from a variety of materials as heavy paper bond, drafting board, inexpensive plastic sheet material and the like" (see col. 3, lines 29-37). Inherently, this would include a material rendering the pouch generally transparent.

Regarding claim 22, the pouch includes a pair of opposed panels (12, 14) joined together at their outer peripheries to form a cavity therebetween (see col. 3, lines 38-68 through col. 4, lines 1-7).

Regarding claim 24, the pouch including a mouth (22) for accessing the inner cavity.

Regarding claim 25, the pouch includes a closure mechanism (40, 42) for selectively closing and opening the mouth.

Regarding claim 26, Friedman discloses the pouch being "made from a variety of materials as heavy paper bond, drafting board, inexpensive plastic sheet material and the like" (see col. 3, lines 29-37). Inherently, this would the pouch being made of a flexible material.

Regarding claim 27, the pouch is generally aligned with the stack of papers such that the longitudinal and lateral edges of the pouch are aligned with a pair of longitudinal and lateral edges of the papers (as seen in figure 2).

Regarding claim 28, see the above rejections to claims 13 and 21.

Regarding claims 29-31, see the above rejections.

Regarding claim 32, Friedman discloses the binding mechanism being a spiral binding mechanism (as seen in figure 2).

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Regarding claim 34, the notebook includes a rear cover (45) bound to the stack of papers and the pouch by the binding mechanism (as seen in figure 2), the rear cover having a greater stiffness than a paper of the stack of papers (see col. 3, lines 26-28).

Regarding claim 35, the rear cover is bound to the stack of papers and the pouch such that the stack of papers can be located between the pouch and the rear cover (as seen in figure 2 – the stack of papers 38 are between the rear cover 45 and the pouch 10).

Regarding claim 36, the pouch includes a pair of opposed panels (12, 14) joined together at their outer peripheries to form a cavity therebetween (see col. 3, lines 38-68 through col. 4, lines 1-7).

Regarding claim 37, Friedman discloses the pouch being “made from a variety of materials as heavy paper bond, drafting board, inexpensive plastic sheet material and the like” (see col. 3, lines 29-37). Inherently, this would include a material rendering both panels of the pouch as being generally transparent.

Regarding claim 38, the pouch including a mouth (22) for accessing the inner cavity.

Regarding claim 39, the pouch includes a closure mechanism (40, 42) for selectively closing and opening the mouth.

Regarding claim 40, the pouch is generally rectangular in top view and including a pair of lateral and longitudinal edges (as seen in figures 1 and 3), wherein the pouch is bound to the stack of papers along one of the lateral edges (as seen in figure 2).

Regarding claim 41, the pouch is generally aligned with the stack of papers such that the longitudinal and lateral edges of the pouch are aligned with a pair of longitudinal and lateral edges of the papers (as seen in figure 2).

5. Claims 18 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman in view of Robinson ('207).

Friedman discloses the claimed invention except for the stack of papers including a plurality of printed guidelines.

Robinson discloses a notebook having a stack of papers, wherein the stack of papers include a plurality of printed guidelines (as seen in figure 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Friedman's invention to include printed guidelines on the stack of papers, as taught by Robinson, to enable the user to provide printed indicia on the papers in a neat and orderly fashion.

Allowable Subject Matter

6. Claim 42 is allowed.

7. Claims 1-3, 5-8, 1-12, 43 and 44 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

8. Applicant's arguments filed July 19, 2004 have been fully considered but they are not persuasive.

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Applicant argues that Friedman fails to disclose the claimed dimensions of the pouch, in particular the longitudinal edges being longer than the lateral edges, and the pouch being bound to the stack of papers along one of the lateral edges. The examiner maintains that it would have been obvious to provide any desired dimensions for the notebook such that either side could be considered the lateral or longitudinal edges, wherein the longitudinal edges are longer than the lateral edges and the notebook is bound to the stack of papers along one of the lateral edges.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 30, 2004

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER